

REMARKS

Entry of the foregoing amendments, reconsideration and allowance of the above-identified application are respectfully requested. Upon entry of the foregoing amendments, claims 8-23 will be pending.

By way of the foregoing amendments new claim 23 has been added. It is respectfully submitted that no new issues are raised thereby, since new claim 23 includes the features of previously presented independent claim 16 and dependent claims 17-19.

Claims 8-11, 16-18, and 21 are rejected under 35 U.S.C §103(a) as being allegedly unpatentable over Thompson et al. (U.S. Patent Number 6,484,011 B1) in further view of Williams et al. (U.S. Patent Number 5,977,964). Prior to discussing this ground of rejection in detail, a brief summary of exemplary embodiments of the present invention are provided below to highlight some of the advantageous characteristics thereof.

According to exemplary embodiments of the present invention, a consumer electronic device has two way communications with a remote control device. The consumer electronic device has the capability to be programmed to keep track of scheduled events through an electronic programming guide. When a scheduled event occurs, the consumer electronic device may transmit a message via the consumer electronic device transmitter to the receiver in the remote control device. When the receiver receives the signal concerning an incoming event from the consumer electronic device, the receiver may transmit a signal to a microprocessor in the remote. The microprocessor may then retrieve instructions from a data storage area in the remote, interpret the signal using the instructions, and provide an alert to a user that a scheduled event is about to occur by activating the speaker (on the remote) and/or the light source (on the remote). Both the light source and the speaker can be customized and/or programmed to provide outputs that represent different scheduled events. Additionally, according to an exemplary embodiment of the present invention, the consumer electronic device does not need to be powered

on when the event occurs. The remote control device will still receive the notification from the consumer electronic device and will alert the user to the event.

The Official Action correctly states that the "Thompson et al. reference discloses receiving selected information at the remote control device (Thompson 5:48-55)" and that "the Thompson et al. reference is silent as to wherein the output device is for providing an alert to a user when a scheduled event occurs."

To remedy the deficiencies of Thompson et al., the Official Action relies on Williams et al., specifically, the Official Action claims that:

"providing an alert to a user when a scheduled event occurs is met by in an alternate embodiment, system controller 104 may provide programming suggestions to a user well in advance (e.g., a couple of days or weeks), with options for issuing reminder prompts, to record the program, or to forego further prompts of the program (Williams et al. 12:36-40)."

However, Applicant respectfully disagrees with this conclusion for at least two reasons. First, there would have been no reason to combine the cited documents because the stated motivation to combine Thompson and Williams is the result of impermissible hindsight reference to Applicant's specification. Second, even assuming (strictly *arguendo*) that the prompts of Williams were somehow grafted onto the information device of Thompson, the result still would not have rendered Applicant's claim 8 combination unpatentable. Each of these points is discussed separately below.

Regarding motivation to combine, the Official Action notes that "the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Thompson et al. data displayed on remote control device with the Williams et al. reminder prompts for the purpose of alerting a user of program events during periods when a television display is in an off state" (emphasis added). The undersigned respectfully disagrees with this statement of motivation because Williams is only concerned with providing prompts to a user when the system is on, as implied by Williams' provision of prompts via interactive pop-up windows (see col. 11, lines 49-53). Since Thompson is admittedly missing this feature of Applicant's claim 8 combination, and Williams is concerned with providing

prompts to a user when the system is on, the alleged motivation recited in the Official Action is respectfully submitted to constitute an impermissible hindsight reference to Applicant's own specification.

Secondly, even if one were to nonetheless combine the prompts of Williams with the system of Thompson, it is respectfully submitted that the result would not have rendered Applicant's claim 8 combination unpatentable. More specifically, Williams describes providing suggestions to a user well in advance (e.g., a couple of days or weeks), with options for issuing reminder prompts, to record a program. See column 12, lines 29-44 of Williams. By way of contrast, Applicant's claim 8 combination refers to, among other things, "a remote control device including an output device in communication with the processor, wherein the output device is for providing an alert to a user when a scheduled event occurs", which differs from the prompts referred to by Williams.

Similar comments apply to independent claim 16, as well as to those claims which depend from claims 8 and 16. Accordingly reconsideration and withdrawal of the rejection of claims 8-11, 16-18, and 21 under 35 U.S.C §103(a) as being allegedly unpatentable over Thompson et al. in further view of Williams et al. are respectfully requested.

Claims 19-20 are rejected under 35 U.S.C §103(a) as being allegedly unpatentable over Thompson et al. (U.S. Patent Number 6,484,011 B1) in further view of Williams et al. (U.S. Patent Number 5,977,964) and Eggen et al. (U.S. Patent Number 6,388,715 B1). Applicant respectfully disagrees, for at least the reasons cited above with respect to claim 16 from which these claims depend.

Additionally, Applicant disagrees with this ground of rejection because there is no motivation for one of ordinary skill in the art to have combined these three documents in a manner to arrive at Applicant's claim 19-20 combinations. For example, Eggen discloses providing sound effects via speaker 5 which is part of a television receiver. Strictly arguendo, if one were to combine Eggen with the combination of Thompson and Williams, at best the result would have been the provision of sound effects at the television receiver not at the remote control device.

Accordingly reconsideration and withdrawal of the rejection of claims 19-20 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Thompson et al. in further view of Williams et al. and Eggen et al. are respectfully requested.

Claims 12-15 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Thompson et al. (U.S. Patent Number 6,484,011 B1) in further view of Williams et al. (U.S. Patent Number 5,977,964) and Croy et al. (U.S. Patent Number 6,509,908 B1). Applicant respectfully submits that these dependent claims are allowable for at least the reasons set forth above with respect to the independent claims from which they depend, since Croy et al. does not remedy the aforementioned deficiencies of Thompson and Williams.

Accordingly reconsideration and withdrawal of the rejection of claims 12-15 and 22 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Thompson et al. in further view of Williams et al. and Croy et al. are respectfully requested.

New claim 23 has been added by way of this response in order to provide additional claim coverage for the present invention. More specifically, claim 23 refers to an exemplary embodiment of the present invention wherein a remote control device includes: a processor; a remote control receiver in communication with the processor, wherein the remote control receiver is for receiving data from an electronic program guide wherein the data indicates the occurrence of a scheduled event; an input device in communication with the processor; an output device in communication with the processor, wherein the output device comprises a speaker and a light source that can be used for providing a customizable alert for a particular scheduled event. This combination of features is not taught nor suggested by Thompson, Williams, Eggen, or Croy.

All of the objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that this application is in condition for allowance and a notice to that effect is earnestly solicited. Should the Examiner have any questions regarding this response or the application in general, he is invited to contact the undersigned at (540) 361-1863.

Respectfully submitted,

POTOMAC PATENT GROUP PLLC

By: 

Steven M. duBois
Registration No. 35,023

Date: March 30, 2005

Potomac Patent Group, PLLC
P.O. Box 270
Fredericksburg, VA 22404
(540) 361-1863